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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-------------------------------|---------------------|------------------|
| 09/763,957 | 06/18/2001 | Rose Ramon Botella Mesa | 229752001300 | 3466 |
| 7590 03/04/2004 | | | | |
| Barry E Bretschneider Morrison & Foerster 2000 Pennsylvania Avenue NW Washington, DC 20006-1888 | | EXAMINER MARVICH, MARIA | | |
| | | ART UNIT PAPER NUMBER 1636 | | |

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------|----------------------------------|-------------------------------------|--|
| Advisory Action | Application No. 09/763,957 | Applicant(s) BOTELLA MESA ET AL. | |
| | Examiner Maria B Marvich, PhD | Art Unit 1636 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 17 December 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____.

Claim(s) objected to: 11-14.

Claim(s) rejected: 1,5,7,9,10,15 and 19-25.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


GERRY LEFFERS
PRIMARY EXAMINER

Continuation of 2. NOTE: The proposed amendment would raise the following new issues that would require new consideration: Claims 1 and 7 have been amended to recite that an isolated nucleic acid (claim 1) or promoter (claim 7) comprise a nucleotide sequence as set forth in SEQ ID NO:3, a nucleotide sequence having at least 70% identity to SEQ ID NO: 3 or a nucleotide sequence capable of hybridizing to SEQ ID NO 3 under stringency conditions of hybridization and washing in 2X SSC, 0.2% w/v SDS at 45C. This amendment changes the scope of the claims from conditions of hybridization that were 6X SSC and 42C and as such raise new issues that would require new consideration. Similarly, claims 15 and 23 have been amended to recite that the conditions of hybridization are 2X SSC and 45C from 6X SSC and 42C and as such raise new issues that would require new consideration.

Continuation of 5. does NOT place the application in condition for allowance because: the applicant's arguments are moot in view of the non-entry of the after final amendment. The claims, if amended as proposed, would not overcome the objection to claims 11-14 based upon multiple dependency.

Furthermore, claim 11 recites dependency upon claims 1, 7, 9 and 22 to 25. Claim 25 has been cancelled by the proposed amendment. Claim 23 does not conform to the newly proposed amendment format in that the status of claim 23 incorrectly indicates that the claim is previously presented when in fact the claim has been amended.